

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENT D. HARRISON,
SCOTT P. THOME,
PETER T. KEITH,
DANIEL O. ADAMS,
and WILLIAM H. PENNY

Appeal No. 97-1313
Application 07/931,695¹

ON BRIEF

Before CALVERT, MARTIN and LEE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 14 and 16 to 25. Claim 15 has been

¹ Application for patent filed August 18, 1992. According to appellants, this application is a continuation-in-part of Application 07/830,479, filed February 4, 1992, which is a continuation-in-part of Application 07/398,756, filed August 25, 1989, now abandoned.

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indicated as allowable if rewritten in independent form. Claims 26 to 29, the other claims in the application, were finally rejected, but in the answer the examiner states that the rejection(s) of those claims has been withdrawn.

The claims on appeal are drawn to an intravascular trapping device and guide catheter combination, and are reproduced in Appendix A of appellants' brief.

The references applied in the final rejection are:

Pollack	4,285,341	Aug. 25, 1981
Frisbie et al. (Frisbie)	4,730,616	Mar. 15, 1988
Saab	4,820,349	Apr. 11, 1989

The appealed claims stand finally rejected as follows:

- (1) Claims 1 to 3, 16, 17 and 21 to 29, provisionally rejected on the ground of obviousness-type double patenting over claims 1, 20 to 29 and 31 of copending application 07/830,479;²
- (2) Claims 1 to 3, 16, 17 and 21 to 29, provisionally rejected on the ground of obviousness-type double patenting over claims 30 to 55 of copending application 07/789,183;
- (3) Claims 1, 6, 21, 24 and 25, unpatentable over Frisbie under either 35 U.S.C. § 102(b) or § 103;³

² Since claims 1, 20 to 24 and 31 of application 07/830,479 were canceled by an amendment filed on September 27, 1993, the basis of this rejection is now limited to claims 25 to 29 of the '479 application.

³ Since claim 6 depends from claim 1 through claims 2, 3 and 4, it is not apparent why claims 2, 3 and 4 were not included in this rejection.

- (4) Claims 16, 17 and 22, unpatentable over Frisbie under 35 U.S.C. § 103;
- (5) Claims 2 to 5, 20 and 23, unpatentable over Frisbie in view of Saab, under 35 U.S.C. § 103;
- (6) Claims 1 to 3, 7, 8, 10, 11 and 16, unpatentable over Pollack under 35 U.S.C. § 102(b) or § 103;
- (7) Claims 9, 12 to 14 and 17 to 19, unpatentable over Pollack under 35 U.S.C. § 103.

Rejection (3)

We will for convenience first consider rejection (3). The examiner sets forth the basis of this rejection on pages 6 and 7 of the answer as:

Frisbie et al. show guide catheter 52, elongate shaft 56, trapping member (balloon 57) and means 34, 37 for preventing the distal end of the trapping member 57 from extending beyond the distal end of the guide catheter when inserted therein. Balloon 57 would be prevented from extending beyond the distal end of the guide catheter when the end cap 37 is tightened while the balloon is located inside of the guide catheter. Note that the apparatus rather than the method of use is claimed in these claims.

Alternatively, it would have been obvious that balloon 57 would be prevented from extending beyond the distal end of the guide catheter when the end cap 37 is tightened while the balloon is located inside of the guide catheter since the seal 34 would frictionally fix the catheter 56 relative to the guide catheter 52. It should be noted that Frisbie et al. indicates that tightening the end cap 37 around a guide wire prevents movement of the guide wire relative to the guide catheter (col. 3, lines 58-59). It is thus apparent that lightening the end cap 37 around balloon catheter 56 likewise prevents movement of the balloon catheter 56 relative to the guide catheter.

Appellants, citing In re Donaldson Co., Inc., 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994), and MPEP § 2181, argue that the end cap 37 of Frisbie, identified by the examiner as corresponding to the "means for preventing" recited in claim 1, is not structure which is the

same as, or an equivalent of, the corresponding structure described in appellants' specification within the meaning of 35 U.S.C. § 112, sixth paragraph (brief, pages 41 to 43; reply brief, pages 4 to 5). The Examiner responds that (answer, page 10):

both end cap 57 [sic: 37] of Frisbie et al. and stop ring 138 of the present invention are alternative mechanisms for preventing the distal movement of the trapping member (balloon) relative to the guide catheter.

In appellants' specification, the structure which corresponds to the claimed "means for preventing" is a stop ring 138 which is located at the connection between the proximal and distal portions 133, 134 of the shaft 132 of the captivation catheter 130 (page 27, lines 10 to 17). As disclosed at page 30, lines 12 to 25:⁴

With the embodiment of FIGS. 9 and 10, the captivation catheter 130 is positioned in the guide catheter 22. Positioning of the captivation catheter 130 is facilitated by the stop ring 138 . . . The physician advances the captivation catheter 130 into the guide catheter 22 until the distal end of the captivation catheter is at the distal portion of the guide catheter but not beyond it. The stop ring 138 is sized such that it will not fit into the guide catheter manifold port and therefore the captivation catheter 130 cannot be advanced so far into the guide catheter 22 that the inflatable balloon 131 extends past the distal end of the guide catheter.

On the other hand, the apparatus identified by the examiner as being the "means for preventing" in the

⁴ The language used in claim 1 to describe the function of the "means for preventing," i.e., "for preventing the distal end . . . when inserted therein," does not appear in the specification. Although we believe that this function is sufficiently described by the quoted portion of page 30 to comply with 35 U.S.C. § 112, first paragraph, the specification should be amended so that there is clear antecedent basis as required by 37 C.F.R. § 1.75(d)(1).

Frisbie patent is the seal ring 34 and cap 37 carried by the body 11 at the end of guide catheter 52. As the examiner indicates in his statement of the rejection, supra, it may be inferred from Frisbie's disclosure that if balloon catheter 56 were within seal ring 34, tightening cap 37 would prevent movement of the balloon catheter relative to the guide catheter.

In Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303, 1308, 46 USPQ2d 1752, 1756 (Fed. Cir. 1998), the Court, in considering whether, under § 112, sixth paragraph, a structure was the equivalent of a structure disclosed in the specification, defined "equivalent" as something which "results from an insubstantial change which adds nothing of significance to the structure, material, or arts disclosed in the patent specification" (quoting Valmont Indus., Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1043, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993)). Applying that definition in this case, we do not consider that the sealing ring-cap arrangement 34, 37 of Frisbie is the equivalent of appellants' disclosed stop ring 138. The stop ring is mounted on the captivation catheter 130 and "automatically" prevents the captivation balloon 131 from extending beyond the distal end of the guide catheter 22 by engaging the guide catheter manifold 56. By contrast, Frisbie's sealing ring and cap are located on the manifold 11, and although they broadly would be capable of performing the function of preventing the balloon 57 from extending beyond the end of the guide catheter 52, they would do so only after the operator had determined by some other means that the balloon had not extended beyond the distal end of the guide catheter, and then tightened the cap to hold the balloon and

its catheter 56 in place. While the Frisbie sealing ring-cap structure and appellants' stop ring may be "alternative mechanisms for preventing the distal movement of the trapping member (balloon) relative to the guide catheter," as the examiner argues on page 10 of the answer, the fact that two structures perform the same function and may be substituted for one another is not determinative of equivalence under § 112, sixth paragraph. Chiuminatta Concrete, 145 F.3d at 1310, 46 USPQ2d at 1757. In our view, Frisbie's sealing ring-cap arrangement is not merely an insubstantial change from appellants' disclosed stop ring, but is a quite different structural arrangement which operates in a different manner.

Accordingly, since the structure disclosed by Frisbie is not, under the sixth paragraph of § 112, the same as or an equivalent of the structure disclosed by appellants as the "means for preventing" recited in claim 1, Frisbie does not anticipate claim 1 under § 102(b). Also, since there is no evidence that such structure disclosed by appellants or its equivalent would have been obvious in view of Frisbie, the rejection of claim 1 under § 103 will likewise not be sustained. It further follows that the rejection of dependent claims 6, 21, 24 and 25 under §§ 102(b) or 103 will not be sustained.

Rejection (4)

This rejection will not be sustained for the same reasons as rejection (3), supra.

Rejections (1) and (2)

In these rejections, the examiner acknowledged that the rejected claims differ from the claims of

the copending applications over which they are provisionally rejected in that they do not include the "means for preventing" recited in claim 1, the parent of all the rejected claims.

However, the examiner takes essentially the same position that he did with regard to rejection (3), i.e., that (answer, page 5):

the use of a locking seal to seal the proximal end of a guide catheter to prevent blood loss is old and well known (noting seal 34 of Frisbie et al. for example). Such a seal is also inherently capable of preventing the distal end of the trapping member from extending beyond the distal end of the guide catheter when inserted therein since the catheter which carries the trapping member would be frictionally locked to the guiding catheter when the seal is compressed by its associated cap (such as cap 37 of Frisbie et al.) while the trapping member is within the guide catheter.

We note that since Frisbie was not included in the statement of these rejections, it should not be considered. Ex parte Raske, 28 USPQ2d 1304, 1305 (BPAI 1993). However, even if it were considered, it does not disclose structure which is the same as or equivalent to appellants' disclosed "means for preventing," as discussed above in connection with rejection (3), and therefore would not provide a basis for concluding that the rejected claims would have been obvious.

Rejections (1) and (2) therefore will not be sustained.

Rejection (5)

This rejection will not be sustained because the additional reference, Saab, applied therein, does not supply the deficiency noted with regard to rejection (3), supra.

Rejections (6) and (7)

On page 8 of the answer, the examiner states the basis of rejection (6) as:

Pollack shows guide catheter 11, shaft 22, trapping member (balloon 21) which is inherently capable of trapping a guide wire inserted through the guide catheter and means 40 for preventing the distal end of the trapping member 21 from extending beyond the distal end of the guide catheter (through openings 16, 41, 48 or 83 for example). As to claim 7, member 40 of Pollack is a stop ring since it abuts the proximal end of the guide catheter at 30.

In considering appellants' arguments concerning this rejection on pages 50 to 54 of their brief, we note that appellants present arguments on pages 51 to 52 concerning obviousness under § 103, but not as to anticipation under § 102(b), even though rejection (6) is based on both of these grounds.

A prior art reference anticipates if it "disclose[s] every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Appellants first argue (brief, pages 52 to 53) that Pollack does not disclose a guide wire. However, as the examiner points out at page 11 of the answer, a guide wire is not part of the claimed combination. Claim 1 recites only a combination "for use with a guide wire", and "[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." In re Schreiber, *id.*

Appellants further argue that Pollack discloses a cannula with a closed distal tip, so that a guide wire or interventional catheter could not pass therethrough. This argument is not well taken because, as the examiner notes (answer, page 12), Pollack discloses in Figs. 8 to 11 embodiments having a distal opening 48, 41 or 83 through which a guide wire or catheter could pass.

Appellants also contend that (brief, pages 53 to 54):

Even if the structure suggested in Pollack is inherently capable of trapping a guide wire, there is no supporting teaching in the prior art for the combination set forth by the Examiner. Pursuant to Smithkline Diagnostics v. Helena Laboratories Corp., [859 F.2d 878, 886-87, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988)] the Examiner appears to be taking a retrospective view of inherency, which is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination. In the present case, the selection and use of a trapping member for trapping a guide wire is claimed, and nothing in the prior art suggests such a combination.

The relevance of this argument to rejections (6) and (7) is not apparent, since the examiner has rejected the claims over a single piece of prior art, and not a combination of references. The examiner did not pick and choose or select elements from the reference, but simply pointed out the elements of Pollack's disclosed apparatus on which the elements recited in the claims are readable. By contrast, the portion of the Smithkline decision cited by appellants is concerned with the question of obviousness over a combination of references, as is evident from the following (id., emphasis added):

Helena cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention. [citation omitted] Helena has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. [citation omitted] A holding that combination claims are invalid based merely upon finding similar elements in separate prior art patents would be "contrary to statute and would defeat the congressional purpose in enacting Title 35." [citation omitted]

From the above-quoted portion of appellants' brief it appears that they may not agree that the Pollack balloon 21, 43 or 46 would inherently be capable of trapping a guide wire, but they have

presented no argument to that effect. Moreover, it appears to us that it would have this capability, since appellants do not disclose that a captivation balloon must have any particular unique characteristics not found in a conventional balloon such as disclosed by Pollack. See In re Schreiber, 128 F.3d at 1478, 44 USPQ2d at 1432.

Finally, appellants argue that Pollack does not suggest the exchange of a first interventional catheter for another while leaving the guide wire in position, as recited in claim 1. However, this is again merely a recitation of an intended use of the apparatus and does not make a claim to the apparatus patentable.

Accordingly, we conclude that claim 1 is anticipated by Pollack under 35 U.S.C. § 102(b).

On pages 54 to 57, appellants assert that various groups of the dependent claims are separately patentable from independent claim 1. The following statement is typical of the reasons given (brief, pages 54 to 55, footnote omitted):

Claims 2-3 are either directly or indirectly dependent from claim 1, and further are limited to an elongated shaft having a flexible proximal portion. An advantage provided by the flexible proximal portion is that the trapping member may be operated from a location other than directly proximal of the proximal end of the guide catheter. In view of thereof, claims 2-3 are deemed separately patentable from claim 1.

We do not regard this statement, and appellants' similar statements concerning the other dependent claims, as sufficient to justify grouping the dependent claims separately from claim 1. As 37 C.F.R. § 1.192(c)(7) states, "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." All appellants have done here is state what subject matter the dependent claims cover, without presenting any reasons as to why they consider that those claims would be patentable (i.e., unobvious) over Pollack. Dependent claims 2, 3, 7 to 14 and 16 to 19 will therefore fall along with claim 1.⁵

Accordingly, rejections (6) and (7) will be sustained.

⁵ The argument presented on page 58 of the brief concerning claim 23 is moot, since claim 23 is not included in rejections (6) or (7).

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Conclusion

The examiner's decision to reject claims 1 to 3, 7 to 14 and 17 to 19 as unpatentable over Pollack is affirmed. His decision to reject the appealed claims on other grounds is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN C. MARTIN)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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